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EXAMINER	
WATKINS III, WILLIAM P	
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Please find below and/or attached an Office communication concerning this application or proceeding.



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UNDER SECRETARY OF COMMERCE FOR
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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re: Shields

Serial no.: 09/267,025

Filed: March 11, 1999

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DECISION
RETURNING
PAPERS

This decision concerns the November 27, 2002 Petition to Terminate Reissue Proceedings or in the alternative to Limit their Scope and attachments. The undersigned Director has the authority to issue this decision.¹

The November 27, 2002 Petition and attachments are **RETURNED** to the Petitioner as improper.

A summary of relevant facts is as follows. On December 8, 1999, the Petitioner filed a petition to institute Public Use proceedings under 37 CFR 1.292 as well as a Protest. On July 24, 2001, an Office Action was issued, to which the applicant responded March 14, 2002. Notice of the Examiner's finding of *prima facie* basis for the Public Use proceeding was mailed on August 8, 2002, and the Public Use proceeding petition was granted November 6, 2002. The Petitioner filed the instant Petition to Terminate Reissue Proceedings or in the alternative to Limit their Scope on November 27, 2002.

Under 35 USC 102(b) and 37 CFR 1.292(a), the public use proceeding is limited to deciding whether on-sale or public use activity occurred more than one year before the priority date for the application. The Public Use proceeding in this case is *ex parte*,² which precludes the Petitioner as a third party from any further involvement therein.

¹ See MPEP 1002.02(c), subpart 3; 1901.03; and 1901.06. This Decision and the Final Decision in the Public Use proceeding are neither appealable nor petitionable. See MPEP 720.05; 1901.07, 1906. All citations to the MPEP refer to the Manual of Patent Examining Procedure (8th ed., August 2001).

² See 37 CFR 1.292(a); and MPEP 720.


Protracted paper filing is discouraged and the Examiner should not answer further queries from the Petitioner.³

The November 27, 2002 Petition is outside the limited scope of a Public Use Proceeding. The Petition includes allegations about inventorship, written description, recapture, broadening, prosecution misconduct, etc. As such, the Petition cannot be considered as the Petitioner's submission of testimony in the Public Use Proceeding.⁴

The only other basis seen for permitting entry of the November 27, 2002 Petition is as a Protest.⁵ As a Protest, however, the Petition is improper because it is not limited to new issues only.⁶ The issues of inventorship, written description, recapture, and broadening have already been addressed on the record.⁷ The PTO does not consider allegations of prosecution misconduct.⁸ As a protest, moreover, the November 27, 2002 Petition is improper as an attempt to supplement the protest previously filed by the Petitioner on December 8, 1999.⁹

The November 27, 2002 Petition still further is improper as an attempt to participate in the on-going examination process of the application.¹⁰ For instance, the Petitioner comments on the merits of the rejections in the July 24, 2001 Office Action and the applicant's arguments in his January 23, 2002 Response. The Petitioner also makes assertions as to purported recapture in the present reissue application and other issues already addressed on the record. Those comments and assertions are tantamount to an attempt to participate in the on-going examination process.

Accordingly, the November 27, 2002 Petition is not entered in the present reissue application as improper. The same Petition and attachments are returned to the Petitioner's attorneys along with a copy of this Decision. A copy of this Decision also is provided to the applicants' attorney.¹¹



Jacqueline Stone, Director
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³ See MPEP 720.02.

⁴ Compare, MPEP 720.04.

⁵ Express or formal abandonments are permitted by the applicant and assignee only. See MPEP 711.01. Other inquiries by third parties are refused. See MPEP 1701. By contrast, MPEP 1900 et seq. permits the filing of Protests by third parties under limited circumstances.

⁶ See MPEP 1901.03, subheading "Initial Protest Submission must be Complete".

⁷ See the September 22, 1999 and July 24, 2001 Office Actions.

⁸ See MPEP 1448.

⁹ See MPEP 1901.03, *supra*.

¹⁰ See MPEP 1901.07, 1901.07(a), and 1907.

¹¹ Telephone inquiries with regard to this decision should be directed to Douglas McGinty, Quality Assurance Specialist in Technology Center 1700, at (703) 308-3805.

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